

REMARKS/ARGUMENTS

Claims 1-18 are pending in the present application. Claims 1 and 8 have been amended. Claims 1, 8, 15, and 17 are independent.

Specification Objection

The Examiner has objected to the title as not being descriptive. Applicants respectfully submit that the title has been replaced with a more descriptive title. Therefore, reconsideration and withdrawal of this objection is respectfully requested.

Prior Art Rejection

Claim 1 stands rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,073,010 to Dufour (hereinafter Dufour). This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed for the following reasons.

As amended, claim 1 recites “determining, at a wireless terminal, whether a received identifier of a...communication service station is at least one of a collection of acceptable identifiers.” Dufour fails to disclose this feature.

Dufour discloses a method performed at a mobile switching center (MSC) for determining whether or not a mobile station is allowed to be handed off to a neighboring cell when the mobile station approaches a cell boundary. Dufour discloses that the MSC includes a database defining the cells belonging to a fixed subscription area (FSA) to which a user of the mobile station subscribes. The MSC may restrict the mobile station from continuing its call (i.e., the MSC may drop the call) after the mobile station roams into a cell that the MSC determines is not part of the subscriber's FSA.

Applicants do not concede that Dufour's MSC performs this function by receiving cell identifiers and determining whether they are included in a collection of identifiers associated with the FSA. However,

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assuming *in arguendo* that this is the case, there is no disclosure in Dufour that the mobile station determines whether a received identifiers is one of a collection of acceptable identifiers, as required by independent claim 1. Thus, Applicants submit that claim 1 is allowable over Dufour.

Claim 8 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Dufour in view of U.S. Patent No. 6,018,655 to Bartle et al. (hereinafter Bartle). Similar to claim 1, claim 8 recites the step of "determining, at a wireless terminal, whether a received identifier of a...communication service station is at least one of a collection of acceptable identifiers." For the reasons discussed above, Dufour fails to teach this feature. Applicants respectfully submit that Bartle fails to remedy this deficiency in Dufour. Thus, Applicants submit that claim 8 is allowable over Dufour and Bartle.

Claims 1, 8, 15, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,255,307 to Mizikovsky (hereinafter Mizikovsky) in view of U.S. Patent No. 5,442,806 to Barber et al. (hereinafter Barber) and Bartle. This rejection is respectfully traversed for the following reasons.

The Examiner admits that Mizikovsky fails to disclose storing a collection of acceptable identifiers (e.g., SIDs) at a mobile station. The Examiner asserts that Barber discloses a plurality of preferred SIDs. The Examiner also asserts that Mizikovsky and Barber fail to disclose an audible or vibrating alert, and thus, relies on Bartle to provide this teaching.

As discussed by the Examiner in section 7, page 6, of the Office Action, the factual inquiries of *Graham v. John Deere Co.*, 148 USPQ 459 (1966) includes (1) determining the scope and contents of the prior art, and (2) ascertaining the differences between the prior art and the claims in question.

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Applicants respectfully submit that the Examiner has failed to adequately perform the second *Graham* inquiry, i.e., to ascertain the differences between the cited prior art and the claims.

Specifically, independent claims 1, 8, 15, and 17 each recite a technique for alerting a wireless terminal user of a handoff of a call from a first service station to a second service station. The recited technique includes activating an audible or vibrating alert during the call if a received identifier is not determined to be one of a collection of acceptable identifiers. Mizikovsky, Barber, and Bartle, taken alone or in combination with one another, fail to disclose these features.

Mizikovsky explicitly discloses that a mobile station does not perform any comparison of a received identifier (SID) while the mobile station is in active mode (i.e., while a call is being handed off). Instead, when an active call is being handed off, Mizikovsky discloses that the base station receiving the handoff will determine whether the mobile station's identifier is one of a collection of stored identifiers. See Mizikovsky at Fig. 4 and column 9, line 58 – column 10, line 17).

Similarly, Barber provides no disclosure of either determining whether an identifier of a service station receiving a call handoff is one of a collection of acceptable identifiers, or producing an alert during a call if the identifier is not an acceptable identifier. Instead, Barber discloses that a cellular phone scans all available carrier frequencies for SIDs and compares them to a list of preferred SIDs to notify the user whether he/she can initiate a call using a preferred carrier. Barber provides no disclosure that such scanning or comparisons is performed while a call is being conducted on the cellular phone.

Bartle fails to teach any comparison of a received service station identifier to one or more acceptable identifiers. Instead, Bartle discloses monitoring and analyzing conditions, e.g., signal quality, to determine whether a change in communication mode will occur.

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Since none of Mizikovsky, Barber, and Bartle disclose the aforementioned features recited in claims 1, 8, 15, and 17, Applicants respectfully submit that these independent claims are allowable.

In addition, Applicants respectfully submit that the Examiner has failed to provide a sufficient motivation for combining these references. For example, in section 9, page 8, the Examiner asserts that it would have been obvious to modify Mizikovsky to include the plurality of preferred SIDs of Barber in order to "allow the mobile station to selectively control the status indicator 48 using said SID's as suggested by Mizikovsky in column 3 lines 41-45." Applicants submit that this statement is a broad conclusory statement, which is insufficient to provide a motivation to combine Mizikovsky with Barber. The Examiner has provided no explanation why it would be beneficial to allow Mizikovsky's mobile station to selectively control a status indicator using a plurality of stored SIDs, as disclosed by Barber.

Thus, Applicants submit that the Examiner is relying on hindsight reasoning, using Applicants' disclosure as a blueprint, to combine Mizikovsky and Barber. Such hindsight reasoning is impermissible. *C.R. Bard, Inc. v. M3 Systems*, 48 U.S.P.Q. 1225 (C.A.F.C. 1998); *Interconnect Planning Corp. v. Feil*, 227 U.S.P.Q. 543 (C.A.F.C. 1998); *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1459 (C.A.F.C. 1998).

Applicants also reassert the arguments presented in previously filed papers that the Examiner is relying on similar hindsight reasoning to modify Mizikovsky in view of the teachings of Bartle. However, for purposes of brevity, these arguments will not be repeated here.

Claims 2-7, 9-14, 16, and 18 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Mizikovsky in view of Barber, Bartle, and U.S. Patent No. 6,201,957 to Son et al. (hereinafter Son). Applicants respectfully submit that Son fails to remedy the deficiencies of Mizikovsky, Barber, and Bartle as discussed above with respect to independent claims 1, 8, 15, and 17. Nor does the Examiner's taking of

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Official Notice (section 10, pages 10-11, of the Office Action) remedy these deficiencies. Thus, Applicants respectfully submit that claims 2-7, 9-14, 16, and 18 are allowable at least by virtue of their dependency on the aforementioned independent claims.

Applicants further reassert their arguments as to claims 6, 7, 13, and 14, as presented in the Appeal Brief filed December 23, 2002. For the purpose of brevity, these arguments will not be repeated here.

CONCLUSION

In view of the above amendments and remarks, reconsideration and withdrawal of all presently outstanding rejections is respectfully requested. In the event that there are any outstanding matters remaining in the present application, the Examiner is encouraged to contact Jason Rhodes at (703) 668-8020 in the Washington, D.C. area, to discuss this application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. 1.16 or under 37 C.F.R. 1.17; particularly, extension of time fees.

Respectfully submitted,

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Approved!!. R.P.G
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